

REMARKS

Upon entry of the present amendments, claims 5, 10-15, 25, 26 and 27 will be pending. Claims 7, 10, 11, 25, and 26 have been amended. The amendments and new claim is supported by the specification and original claims and, therefore, do not add new matter.

Rejections Under 35 U.S.C. §112, First Paragraph

Claims 11-15 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement.

Applicants respectfully traverse this rejection against amended claim 11, including as it may be applied to claims dependent therefrom, for the reasons given below.

The Office Action alleges that polynucleotide elements as recited in claims 11-15 embrace subsequences of those sequences recited in the base claim 7, and in fact alleges that the dependent claims embrace any two or more nucleotides which comprise the sequences recited in the base claim. Applicants respectfully disagree with such an interpretation because a dependent claim must contain all of the limitations of the base claim from which it depends. Therefore, embraced sequences in view of the base claim must, for example, encode the amino acids as set forth in SEQ ID NO:2 (i.e., claim 7(a)). Such embraced sequences would not include polynucleotides consisting of two nucleotides. Further, the remaining sub-clause elements must be a minimal length (e.g., in 7(b) the length is delimited because the RNA must be of a minimal length to encode the amino acids of SEQ ID NO:2; in 7(c) the length is delimited because the polynucleotide is the complete counterpart to either (a) or (b); and in 7(d) the length is delimited because the recited sequence identifier defines it). Again, nucleotide sequences consisting of two residues, for example, would not be embraced.

Nevertheless, while Applicants do not acquiesce to the reasoning offered in the Action, and to expedite prosecution of the claims toward allowance, claim 11 has been amended to more clearly define which polynucleotides may comprise the vector recited in the claim.

For these reasons, Applicants respectfully request that the rejection against amended claim 11, including as it may be applied to claims dependent therefrom, be withdrawn.

Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 7, 11-15, 25 and 26 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

Applicants respectfully traverse this rejection against amended claims 7, 11-15, 25, and 26 for the reasons given below.

The Office Action alleges that sub-clause (d) of claim 7 makes the claim unclear. While not acquiescing to the reasoning offered in the Action, and to expedite prosecution to allowance, Applicants have amended claim 7 to more clearly define the invention. As claims 11-15 depend from claim 7, and as they have been rejected because of this dependency, the amendment to claim 7 addresses the indefinite issue regarding these claims.

Further, the Office Action alleges that for claim 25, the sequence identifier recited does not have proper antecedent basis. Claim 25 has been amended to recite SEQ ID NO:2, thus, the antecedent issue as applied against claim 25 has been addressed.

Moreover, the Action alleges that claim 26 is indefinite because the base claim from which it depends has been canceled. Claim 26 has been amended to read as an independent claim. Thus, the base claim issue regarding claim 26 has been addressed.

For the reasons given above, Applicants respectfully request that the rejection against claims 7, 11-15, 25, and 26 be withdrawn.

Rejections Under 35 U.S.C. §102

Claims 11-15 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Goodearl et al.

Applicants respectfully traverse the rejection against amended claims 11-15 for the reasons given below.

At the onset, as a dependent claim shall include every limitation of the claim from which it depends, it is not clear as to how dependent claims 11-15 can be anticipated by the cited reference and the base claim from which they depend is not. See, e.g., M.P.E.P. section 608.01(n), III.

Nevertheless, as amended claim 11 expressly recites which polynucleotide elements in base claim 7 may comprise the recited vector, and because the amended claims include every limitation of base claim 7, as base claim 7 is free of the cited art, amended claims 11-15 are also free of said cited art.

For these reasons, Applicants respectfully request that the rejection as it might be applied to amended claims 11-15 be withdrawn.

Claim 26 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Schlegel et al.

Applicants respectfully traverse the rejection against amended claim 26 for the reasons given below.

The Office Action states, in pertinent part, that Schlegel et al. does teach polynucleotides as set forth in the residues 1-331, 799-903, 1232-1543, 2147-2486 or 2964-4756 of SEQ ID NO:3. Further, referring to line 3 of the claim, the Action intimates that because the claim can be construed to include full length as well as fragments of the sequence identifier, sequence differences between the instant polynucleotide and that of the cited reference do not distinguish the claim over Schlegel et al. Respectfully, this is a very strained interpretation of the claims.

As amended in the previous response of April 14, 2005, the recitation “a polynucleotide having the nucleotide sequence as set forth in SEQ ID NO:3” cannot be interpreted to include fragments because of the definite article “the.” When a definite article is placed before a noun modified (“sequence”) by an attributable noun (“nucleotide”) as in “the nucleotide sequence,” the definite article functions to limit the application of the modified noun (“sequence”) to that

specified by the attributable noun ("as set forth in SEQ ID NO:3"). Thus, grammatically, the claim cannot be interpreted to include less than the sequence as set forth in the identifier. Therefore, while the present amendment to the first sub-clause can be interpreted to contain additional sequences (e.g., linkers, tags, fusion proteins, etc.), it cannot be interpreted to include sub-fragments of SEQ ID NO:3.

Regarding ranges recited in the second sub-clause as amended, each of the fragments contains at least one of the residues which is not recited in the sequence alleged to anticipate the claim (i.e., residue 1963 and/or residue 2071). As Schlegel et al. do not teach either of these residues in the sequence alleged to anticipate the claim, Schlegel et al. do not teach all of the elements of the claim. Therefore, as all of the claim elements are not taught by a single reference, the reference does not anticipate the claim.

For these reasons, Applicant respectfully requests that the rejection against claim 26 be withdrawn.

Claim 10 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Goodearl et al.

While not acquiescing to the arguments offered in the Action, and to expedite prosecution to allowance, Applicants have amended the claims based on the suggestion recited in the Action.

For this reason, Applicants respectfully request that the rejection against amended claim 10 be withdrawn.

In re Application of:
Kumagai and Dunphy
Application No.: 09/982,091
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In view of the above amendments and remarks, Applicants believe that all claims are now in condition for allowance, which action is respectfully requested. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to this application.

Please charge any additional fees, or make any credits, to Deposit Account No. 07-1896.

Respectfully submitted,

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